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SUBJECT: Amendments to the Implementing Regulations for EPC 2000 - epi comments

DRAWN UP BY: Institute of Professional Representatives before the European Patent Office (epi)

ADDRESSEES: Committee on Patent Law (for opinion)

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Institut der beim Europäischen Patentamt zugelassenen Vertreter

Institute of Professional Representatives before the European Patent Office

Institut des mandataires agréés près l'Office européen des brevets

The President

Professeur Alain Pompidou,
The President,
The European Patent Office,
Erhardstrasse,
Munich,
Germany

19th October, 2006

Dear Professeur Pompidou,

Re: Amendments to the Implementing Regulations for EPC 2000

epi held a Council meeting earlier this week. At that Council meeting, the suggested amendments to the Implementing Regulations for EPC 2000 were discussed. In general, epi believes that the progress with the amendments to the Regulations is very good and we are pleased to see that a number of suggestions made by epi for improvements to the Regulations have been adopted. However, we feel that in four places, the proposed Regulations are not acceptable and we therefore request that in these four places, the Regulations are further amended.

I attach four position papers regarding the four places where we feel further amendment is needed. I believe that these papers are self-explanatory.

I hereby request that you transmit these papers to the delegations to the Committee on Patent Law so that they can be considered in good time before its next meeting on 2nd November, 2006.

I am sending a copy of this letter and the papers to Mr. Ficsor.

Yours truly

Chris P. Mercer
President

cc – Mr. Mihaly Ficsor – Chairman of the Committee on Patent Law

Enclosed – Position papers on new Regulations 1, 56, 78 and 156a

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epi **position paper**

Requirement to use the written form in EPC 2000

Both the first draft as submitted to SACEPO and the second draft as submitted to the 30th meeting of the Committee on Patent Law (CPL) contained in substance the following provisions:

Rule 1 - Written proceedings

In written proceedings before the European Patent Office the requirement to use the written form shall be satisfied if the content of the documents can be reproduced in a legible form on paper or on screen.

Rule 2 - Filing of and formal requirements for documents

(1) In proceedings before the European Patent Office, documents may be filed directly, by post or by technical means of communication the use of which has been permitted by the President of the European Patent Office. The President shall lay down the conditions and, where appropriate, any special formal requirements for the use of the technical means. [...]

At the request of the Romanian delegation, which found the draft "difficult to understand", the majority of the delegations decided to delete from Rule 1 the words *"on paper or on screen".*

epi believes that it is important to retain a requirement for the content of any and all documents to be reproducible on paper. Unless this result is achieved, applicants, patentees and third parties might be confronted with documents that can only be viewed on screen, causing serious problems. It is more than frequent to have to view several documents at the same time (e.g. application and prior art; patent, notice of opposition and prior art), what would become very difficult if they could not be printed.

epi believes that it is further important because the appearance of a document on a screen can alter depending on the type and settings of the screen. Such factors can undesirably affect the interpretation of a document. Sometimes this can happen without the person viewing the document realising that the document is not being shown in the form in which it was created.

epi believes that there is no need for having on file any document that could not be reproduced on paper. In particular, 3-D objects have long been reproduced in 2-D, in particular in the field of mechanics.

epi acknowledges that it supports the filing of documents and applications by electronic means, however it does not support the filing of documents that cannot be reproduced on paper.

epi further believes that the rights of the public might be affected if special technologies were required to access the content of patent documents or files.

Accordingly, ***epi*** kindly requests that the Implementing Regulations of EPC 2000 be amended in such a way as to ensure that any and all document on file can be reproduced on paper. Inserting the words "on paper" at the end of Rule 1 as presently agreed by the Committee on Patent Law would appear to be the easiest way of achieving this purpose.

Adopted by ***epi*** at its Council meeting of 16-17 October 2006.

epi position paper

EPC 2000

Rule 56 - Missing parts of the description or missing drawings.

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1. ***epi*** requests that Rule 56 applies to parts of drawings as well as to drawings. There may be situations where a small part of a drawing is missing, but the applicant is satisfied. In such case, if the situation were treated as if the entire drawing was missing, the sanction would be the removal of any reference to the entire drawing, which appears excessive. In the absence of a definition of "drawings", the situation wherein several figures appear on one page, and only one figure is missing, may have the same excessive result.

2. ***epi*** believes that the wording of Rule 56 as submitted to the 30th meeting of the Committee on Patent Law is globally unclear, and submits a proposed wording for Rule 56, as per copy attached. Incidentally, the sanction "deemed not to have been made" in the CA/PL 17/06 version of Rule 56(4) would be a violation of EPC, PCT, PLT, etc insofar as it would relate to something that actually was in the application as filed (it is however correct for missing parts/drawings filed later then withdrawn to avoid re-dating). The ***epi*** proposal follows the logical structure of Rule 56 in CA/PL 17/06: (1) principle, (2) no prior application, (3) prior application, (4) late filed or withdrawn, (5) sanctions.

3. ***epi*** believes that using the procedure of Rule 56(3), as presently envisaged, would lead to a violation of Article 123(2), contrary to its very purpose. Said procedure was inspired by a similar procedure under PCT, however PCT (R.4.18) provides a check box to incorporate the content of the priority document in the application for the sole purpose of applying the equivalent rule (R.20.6) to avoid adding new matter. In the absence of such incorporation by reference, Article 123(2) would be violated. Accordingly, ***epi*** requests that the same should be provided under EPC 2000: incorporation by reference must be provided in R. 41(2)(g) for the sole purpose of applying R. 56(3).

Adopted by ***epi*** at its Council meeting of 16-17 October 2006.

Encl.: ***epi*** proposal for R. 56 EPC 2000.

Rule 56

(1) If the examination under Article 90, paragraph 1 reveals that the drawings referred to in the description or the claims or part of the description or part of the drawings appears to be missing, the European Patent Office shall issue a communication inviting the applicant to file the missing drawings or the missing parts of the description or drawings within two months of the issue of the communication. The applicant may not invoke the omission of such a communication.

(2) If the drawings or the missing parts are filed later than the date of filing, but within two months of the date of filing of the application or of the date of the communication specified in paragraph 1, the application shall be re-dated to the date on which the drawings or the missing parts were filed. The European Patent Office shall issue a communication informing the applicant of the new date of filing.

(3) If the drawings or the missing parts are filed within the period specified in paragraph 2, the date of filing shall remain the date on which the requirements laid down in Rule 40, paragraph 1 were fulfilled provided that:

(a) the application claims priority from an earlier application;

(b) the drawings or the missing parts are completely contained in the earlier application; and

(c) within the period specified in paragraph 2, the applicant files:

(i) a request that the application shall not be re-dated;

(ii) a copy of the earlier application, unless Rule 53, paragraph 2 applies;

(iii) where the earlier application is not in an official language of the European Patent Office, a translation thereof in one of those languages, unless Rule 53, paragraph 2 applies; and

(iv) an indication as to where the drawings or the missing parts are completely contained in the earlier application and, where applicable, in the translation thereof.

(4) If the applicant fails to comply with the requirements referred to in paragraph 3 (c) within the period specified in paragraph 2, the application shall be re-dated to the date on which the drawings or the missing parts were filed. The European Patent Office shall issue a communication informing the applicant of the new date of filing.

(5) If, within one month of the issue of the communication referred to in paragraph 2 or paragraph 4, the applicant withdraws the drawings or the missing parts, the re-dating shall be cancelled. The European Patent Office shall issue a communication informing the applicant that the re-dating has been cancelled.

(6) If the applicant:

(a) fails to file the drawings or the missing parts within the period specified in paragraph 1 or paragraph 2; or

(b) withdraws the drawings or the missing parts in accordance with paragraph 5

any formal reference to the drawings or the missing parts shall be deemed to be deleted whilst any description of the drawings or the missing parts shall be retained.

epi position paper

EPC 2000

Procedure when the patentee is not entitled to the grant of the European patent.

Stay of proceedings (previously known as "suspension of proceedings")

Both the first draft as submitted to SACEPO and the second draft as submitted to the 30th meeting of the Committee on Patent Law contained in substance the following provisions:

Rule 78 - Procedure where the proprietor of the patent is not entitled

(1) If a third party provides evidence, during opposition proceedings or during the opposition period, that he has instituted proceedings against the proprietor of the European patent, seeking a decision within the meaning of Article 61, paragraph 1, opposition proceedings shall be stayed unless the third party communicates to the European Patent Office in writing his consent to the continuation of such proceedings. Such consent shall be irrevocable. However, proceedings shall not be stayed until the Opposition Division has deemed the opposition admissible. Rule 14, paragraphs 2 and 3, shall apply mutatis mutandis.

Rule 14 - Stay of proceedings

(2) Where evidence is provided that a final decision within the meaning of Article 61, paragraph 1, has been taken, the European Patent Office shall inform the applicant and any other party that the proceedings for grant shall be resumed as from the date stated in the communication, unless a new European patent application under Article 61, paragraph 1(b), has been filed for all the designated Contracting States. If the decision is in favour of the third party, the proceedings may not be resumed earlier than three months after the decision has become final, unless the third party requests the resumption.

(3) Upon staying the proceedings for grant, or thereafter, the European Patent Office may set a date on which it intends to resume the proceedings for grant regardless of the stage reached in the national proceedings instituted under paragraph 1. It shall communicate this date to the third party, the applicant and any other party. If no evidence has been provided by that date that a final decision has been taken, the European Patent Office may resume proceedings.

During the meeting, ***epi*** requested that reference be made in Rule 78(1) also to Rule 14(4), else it would be unclear what the effects of the stay would be during the opposition procedure:

Rule 14 - Stay of proceedings

(4) All periods other than those for the payment of renewal fees, running at the date of the stay of proceedings, shall be interrupted by such stay. The time which has not yet elapsed shall begin to run as from the date on which proceedings are resumed. However, the time still to run after such resumption shall not be less than two months.

In the old EPC 1973, what is now Rule 78(1) was in the same Rule 13 as what is now Rule 14(4), and the effect of the stay was thus clear. If no reference to Rule 14(4) is made in Rule 78(1), the effects of the stay will be unclear.

During the 30th meeting of the Committee on Patent Law, the Chairman said that the EPO would look into the matter, and it would be revisited the next day, but it was never discussed again. Thus, ***epi*** repeats its request to have a reference to Rule 14(4) inserted in Rule 78(1).

Adopted by ***epi*** at its Council meeting of 16-17 October 2006.

epi position paper

EPC 2000

Payment of renewal fees of European patents during re-establishment under Article 122 or the new procedure of re-opening of proceedings before the Board of Appeal under Article 112a(5).

Re-establishment under Article 122 EPC has long been available to patentees during the opposition or subsequent appeal procedure:

> *(1) The [...] proprietor of a European patent who, in spite of all due care required by the circumstances having been taken, was unable to observe a time limit vis-à-vis the European Patent Office shall, upon application, have his rights reestablished if the non-observance in question has the direct consequence, by virtue of this Convention, of causing [...] the revocation of the European patent, or the loss of any other right or means of redress.*

The question of the payment of the renewal fees has apparently never been raised, presumably because there are not many such time limits to be observed by a proprietor in the opposition or subsequent appeal procedure, also because of the strict interpretation of the requirement of "all due care required by the circumstances having been taken".

EPC 2000 introduces a new procedure, namely the re-opening of proceedings before the Board of Appeal under Article 112a:

> *(1) Any party to appeal proceedings adversely affected by the decision of the Board of Appeal may file a petition for review of the decision by the Enlarged Board of Appeal.*
>
> *(2) The petition may only be filed on the grounds that:*
>
> *(a) a member of the Board of Appeal took part in the decision in breach of Article 24, paragraph 1, or despite being excluded pursuant to a decision under Article 24, paragraph 4;*
>
> *(b) the Board of Appeal included a person not appointed as a member of the Boards of Appeal;*
>
> *(c) a fundamental violation of Article 113 occurred;*
>
> *(d) any other fundamental procedural defect defined in the Implementing Regulations occurred in the appeal proceedings; or*
>
> *(e) a criminal act established under the conditions laid down in the Implementing Regulations may have had an impact on the decision.*
>
> *(3) The petition for review shall not have suspensive effect.*
>
> *(4) The petition for review shall be filed in a reasoned statement, in accordance with the Implementing Regulations. If based on paragraph 2(a) to (d), the petition shall be filed within two months of notification of the decision of the Board of Appeal. If based on paragraph 2(e), the petition shall be filed within two months of the date on which the criminal act has been established and in any event no later than five years from notification of the decision of the Board of Appeal.*
>
> *(5) The Enlarged Board of Appeal shall examine the petition for review in accordance with the Implementing Regulations. If the petition is allowable, the Enlarged Board of Appeal shall set aside the decision and shall re-open proceedings before the Boards of Appeal in accordance with the Implementing Regulations.*

The new procedure under Article 112a provides a means of redress to (amongst others) patentees whose patents have been revoked in proceedings that may have been unfair to them for one of the reasons (a) to (e) above.

During the process of revising the Implementing Regulations of EPC 2000 that had been adopted in 2002, the EPO proposed in document CA/PL 17/06 to insert new provisions dealing with the payment of renewal fees for European patent applications that were subject to the above procedures. The explanatory notes read as follows (emphasis in the original):

> 1. It is proposed to insert a **new paragraph 4 in Rule 51 (ex 37) EPC** providing that after a successful request for re-establishment of rights under Article 122 EPC those renewal fees which, because of the retrospective effect of the reestablishment decision, would have become due in the time between the date on which the loss of rights has occurred and the decision re-establishing the rights of the applicant, shall become due only on the date of *the notification of that decision*. These renewal fees can still be paid without surcharge within a period of four months after that date. If not paid within this period, Rule 51(2) EPC shall apply, i.e. the fees can still be paid with a surcharge up to the expiry of a period of six months after that date.
>
> This new provision will amend a current practice according to which, after a first loss of rights, the renewal fees still have to be paid at the regular dates in order to avoid a second loss of rights which, according to this practice, can occur under Article 86 (3), first sentence, EPC 1973, due to the retrospective effect of the reestablishment of rights.
>
> 2. An analogous situation exists where a petition for review is successful. Therefore a **new paragraph 5 in Rule 51 (ex 37) EPC** is proposed likewise providing that the renewal fees, which would be due retrospectively by the effect of the decision of the Enlarged Board of Appeal, shall become due only on the date of *the notification of the decision of the Enlarged Board ordering re-opening of proceedings*.

These explanatory notes clearly explain that a successful request for re-establishment of rights under Article 122 EPC or a successful petition for review under Article 112a EPC 2000 might not lead to the desired result if a loss of rights occurred in the meantime through non-payment of the renewal fees.

At the European Patent Office, the practice has thus developed to accept payment of the renewal fees when a request is filed for re-establishment of rights under Article 122 EPC. One of the problems is that the renewal fee had first been reimbursed as a result of the loss of rights, and must be paid again. Also, if the request is unsuccessful, the renewal fees falling due after the loss of rights have to be reimbursed. There was however no sound legal basis for such a practice, and the EPO thus proposed to introduce new Rule 51(4). Logically, a new Rule 51(5) was proposed to deal with the similar case of a petition for review under Article 112a EPC 2000.

Whenever these procedures involve a European patent, new paragraphs (4) and (5) of Rule 51 do not apply. The payment of renewal fees of European patents is governed by national law. A successful request for re-establishment of rights under Article 122 EPC or a successful petition for review under Article 112a EPC 2000 might also not lead to the desired result if a loss of rights occurred in the meantime through non-payment of the renewal fees for the European patent. Most (if not all) of the national laws do not contain special provisions that allow for the payment of renewal fees for European patents that have been revoked, or for the later payment of renewal fees accrued during a period of loss of rights.

epi believes that such an undesired result could not have been the intention of the Contracting States when they signed then ratified or adhered to EPC 2000.

Whilst ***epi*** is confident that each and every Contracting State would endeavour to introduce appropriate provisions in its national laws, it would appear that the sole possibility to avoid

such an undesired result as from the entry into force of EPC 2000 would be to introduce provisions in the Implementing Regulations to EPC 2000.

Article 2 EPC provides:

> *(2) The European patent shall, in each of the Contracting States for which it is granted, have the effect of and be subject to the same conditions as a national patent granted by that State, unless this Convention provides otherwise.*

The competence of the Administrative Council would be based on the fact that the Diplomatic Conference has confirmed the procedure for re-establishment under Article 122 EPC and introduced a new procedure of re-opening of proceedings before the Board of Appeal under Article 112a(5) EPC 2000, and that the new provisions are indispensable to guarantee that they reach the desired result.

Thus, ***epi*** urges the Contracting States to approve the introduction of a new rule in Part VIII of the Implementing Regulations of EPC 2000, based on the language of Rule 51(4)(5), e.g.:

> **Rule 156a -** Renewal fees for European patents
>
> (1) If rights are re-established under Article 122, a renewal fee
>
> (a) which would have fallen due in respect of a European patent in the period starting on the date on which the loss of rights occurred, up to and including the date of the notification of the decision reestablishing the rights shall be due on that latter date.
>
> Notwithstanding any grace period, this fee and any renewal fee due within four months from that latter date may still be paid within four months of that latter date without an additional fee.
>
> (b) which, on the date on which the loss of rights has occurred, was already due but the period of grace has not yet expired, may still be paid within six months from the date of the notification of the decision reestablishing the rights, provided that any additional fee required during the grace period is also paid within that period.
>
> (2) If the Enlarged Board of Appeal reopens proceedings before the Board of Appeal under Article 112a, paragraph 5, second sentence, a renewal fee
>
> (a) which would have fallen due in respect of a European patent in the period starting on the date when the decision of the Board of Appeal subject to the petition for review was taken up to and including the date of the notification of the decision of the Enlarged Board of Appeal re-opening proceedings before the Board of Appeal shall be due on that latter date.
>
> Notwithstanding any grace period, this fee and any renewal fee due within four months from that latter date may still be paid within four months of that latter date without an additional fee.
>
> (b) which, on the day on which the decision of the Board of Appeal was taken, was already due but the grace period has not yet expired, may still be paid within six months from the date of the notification of the decision of the Enlarged Board of Appeal re-opening proceedings before the Board of Appeal, provided that any additional fee required during the grace period is also paid within that period.

Adopted by ***epi*** at its Council meeting of 16-17 October 2006.